

Remarks

This Application has been carefully reviewed in light of the Final Office Action mailed November 29, 2004. Applicant appreciates the Examiner's further consideration of the Application. Although Applicant believes all claims are allowable without amendment, Applicant has made clarifying amendments to Claims 1, 12, 23, and 34-35. These amendments are not considered narrowing or necessary for patentability. Applicant respectfully requests reconsideration and allowance of all pending claims.

I. Summary of Telephone Interview

Attorneys for Applicant thank the Examiner for the courtesy of the telephone interview conducted on January 21, 2004, and submit this Summary pursuant to M.P.E.P. § 713.04. During the telephone interview, Applicant discussed the Examiner's rejections of Claims 1-22 and 35 under 35 U.S.C. § 112, second paragraph. With respect to independent Claims 1 and 35, although Applicant believes Claims 1 and 35 comply with 35 U.S.C. § 112, second paragraph, without amendment, Applicant agreed to make certain clarifying amendments to Claims 1 and 35. These amendments are not considered narrowing or necessary for patentability, are made to simplify issues for Appeal, do not add any new matter, and do not require a new search to be performed. The Examiner agreed to enter these amendments. With respect to independent Claim 12, the Examiner agreed that this claim complies with 35 U.S.C. § 112, second paragraph, without amendment.

II. Claims 1-22 and 35 Comply with 35 U.S.C. § 112, Second Paragraph

The Examiner rejects Claims 1-22 and 35 under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter Applicant regards as the invention. Applicant respectfully disagrees.

Applicant reiterates all arguments presented in the previous Response as to why Claims 1-22 and 35 complied with 35 U.S.C. § 112, second paragraph, prior to the amendments presented in this Response. However, as discussed above in the Summary of the Telephone Interview, Applicant has made clarifying amendments to Claims 1 and 35. These amendments are not considered narrowing or necessary for patentability, are made to simplify issues for Appeal, do not add any new matter, and do not require a new search to be

performed. The Examiner has agreed to enter these amendments. With respect to independent Claim 12, the Examiner has agreed that this claim complies with 35 U.S.C. § 112, second paragraph, without amendment.

For at least these reasons, Applicant respectfully requests that the Examiner withdraw the rejections of independent Claims 1, 12, and 35 and their dependent claims under 35 U.S.C. § 112, second paragraph.

III. The Claims are Allowable over *Mathur*

The Examiner rejects Claims 1-35 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,581,072 to Mathur et al. ("*Mathur*"). Applicant respectfully disagrees and discusses Claim 23 as an example.

A. Independent Claims 1, 12, 23, and 34 are Allowable over *Mathur*

Applicant again notes that the Examiner has merely summarized a portion of *Mathur* and concluded that the limitations recited in all of Applicant's claims are anticipated by *Mathur* rather than note which *specific* teachings in *Mathur* are purportedly relevant to *each element of each of Applicant's claims* (including each of Applicants' dependent claims) and why such teachings are purportedly relevant. Thus, Applicant has been forced to speculate as to which portions of *Mathur* the Examiner equates with which limitations recited in Applicant's claims.

The Examiner apparently relies on several vague statements in *Mathur*, which Applicant summarized in the previous Response, as disclosing the very concrete limitations recited in Applicant's claims. At best, these statements in *Mathur* merely disclose a search engine that resolves a user's search queries for web documents such as web pages, presents the results to the user, and tracks certain information related to the user's requests and selection of documents from among those presented.

However, *Mathur* fails to disclose, teach, or suggest each and every limitation recited in Claim 23.

1. *Mathur* Fails to Disclose, Teach, or Suggest “Product Data” and “One or More Databases Containing Product Data”

As a first example, as Applicant pointed out in the previous Response, *Mathur* fails to disclose, teach, or suggest “product data” and “one or more databases containing product data,” as recited in Claim 23. Rather, the cited portion of *Mathur* appears to be concerned merely with conventional search engines such as Yahoo, Google, Lycos, Excite, Altavista, and the like, which search for web pages matching search queries. (See Column 2, Line 63 through Column 3, Line 2) Since *Mathur* fails to disclose, teach, or suggest “product data” and “one or more databases containing product data,” as recited in Claim 23, *Mathur* necessarily fails to disclose, teach, or suggest at least the following limitations as specifically recited in Claim 23 prior to amendments presented in this Response:

- recording query information associated with ***a search query for a buyer of one or more databases containing product data;***
- recording presentation information associated with presentation of a plurality of search results to the buyer, ***each search result comprising data for a product matching one or more search criteria specified in the search query, the search results comprising one or more search results reflecting product data for a particular seller;***
- recording selection information associated with selection by the buyer of a particular search result from among the plurality of search results, ***the particular search result comprising data for a particular product matching one or more search criteria specified in the search query;*** and
- providing at least some of the recorded query information, presentation information, or selection information to the particular seller ***to allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers.***

These distinctions are not changed as a result of the amendments presented in this Response.

Applicant agrees that *Mathur* disclosing searching other databases would not necessarily mean that *Mathur* does not anticipate Applicant's claims, provided *Mathur* actually disclosed searching “product data” and “one or more databases containing product data,” as recited in Claim 23, along with all other limitations recited in Claim 23. (See Final Office Action, Page 6) However, *Mathur* does not disclose “product data,” “one or more databases containing product data,” and various other limitations recited in Claim 23.

2. Mathur Fails to Disclose, Teach, or Suggest “Presentation Information”

As a second example, even prior to the amendments presented in this Response, *Mathur* failed to disclose, teach, or suggest “*recording presentation information associated with presentation of a plurality of search results to the buyer, each search result comprising data for a product matching one or more search criteria specified in the search query, the search results comprising one or more search results reflecting product data for a particular seller,*” as recited in Claim 23. *Mathur* discloses that a search engine executing on a remote server may receive a query and identify documents (or locations of the documents) that match or satisfy the query based on information stored in the index used by the search engine. (Column 3, Lines 46-50) Information identifying the relevant documents or their locations (e.g., web pages identified by their URLs) is then communicated from the search engine server to the user’s computer. (Column 3, lines 52-57; Column 4, Lines 15-16) *Mathur* further discloses that several search engines mine information contained in search queries and track the contents of documents (e.g., web pages) accessed by the user using the search engine (e.g., the web pages accessed by the user, the content of the web pages, and transactions performed by the user using the web pages). (Column 4, Lines 31-44)

First, *Mathur* does not disclose, teach, or suggest “*each search result comprising data for a product matching one or more search criteria specified in the search query, the search results comprising one or more search results reflecting product data for a particular seller,*” as recited in Claim 23 even prior to the amendments presented in this Response. Second, nothing in these cited portions discloses anything related to recording presentation information, let alone a server operable to “*record presentation information associated with presentation of a plurality of search results to the buyer,*” as recited in Claim 23 even prior to the amendments presented in this Response. The Examiner has not indicated what in the cited portion of *Mathur* the Examiner believes discloses “presentation information” as recited in Claim 23. In any event, Applicant respectfully submits that tracking the web pages accessed by the user, the content of the web pages, and transactions performed by the user using the web pages as disclosed in *Mathur* have nothing to do with “presentation information associated with presentation of a plurality of search results to the buyer,” let alone recording such presentation information as recited in Claim 23 even prior to the amendments presented in this Response.

Applicant has amended Claim 23 to more clearly recite that presentation information is “*associated with the manner in which a plurality of search results are presented to the buyer,*” which *Mathur* even more clearly fails to disclose, teach, or suggest. These distinctions were present in Claim 23 even prior to the amendments presented in this Response; however, Applicant has amended independent Claim 23 (and the other independent claims) to further clarify this distinction. These amendments place the Application in better form for Appeal and do not require a new search. Applicant therefore respectfully requests that the Examiner enter these amendments.

3. *Mathur* Fails to Disclose, Teach, or Suggest Allowing a Seller “to Assess One or More Aspects of its Product Data Relative to Product Data of Other Sellers”

As a third example, even prior to the amendments presented in this Response, *Mathur* failed to disclose, teach, or suggest a server operable to “*provide at least some of the recorded query information, presentation information, or selection information to the particular seller to allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers,*” as recited in Claim 23. *Mathur* merely discloses that the user information collected by the search engines and the user profile information built by the search engines may be distributed or even sold by providers of search engines to entities such as advertising agencies, government agencies, insurance companies, and other entities. (Column 4, Lines 55-61) The deficiencies of *Mathur* with respect to disclosing query information, presentation information, and selection information as recited in Claim 23 are made even more clear given that the type of information distributed or sold by the search engine providers as disclosed in *Mathur* would not “allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers,” as recited in Claim 23. For example, merely distributing or selling information regarding a particular user’s interests (e.g., browsing habits as recorded in a user profile) would not “allow the particular seller [which is not disclosed in *Mathur*] to assess one or more aspects of its product data [which is also not disclosed in *Mathur*] relative to product data of other sellers,” as recited in Claim 23.

Instead, *Mathur* merely discloses that the information collected by the system disclosed in *Mathur* (e.g., information contained in user search queries for web pages, the web pages accessed by the user, the contents of documents accessed by the user, and transactions performed by the user using the web pages) can be used to ascertain information about the user's interests and shopping preferences and to build a detailed profile, over time, of the user and the user's behavior. According to *Mathur*, this user profile can then be sold to various entities, and the user may then be subjected to unsolicited spam mail messages, unwelcome advertisements, credit card fraud, mail fraud, banking fraud, and other unwelcome activities. *Mathur* does not disclose, teach, or suggest that the type of user-specific information collected by the system disclosed in *Mathur* would enable a seller to whom the information is sold to "assess one or more aspects of its product data relative to product data of other sellers," as recited in Claim 23. In other words, *Mathur* still fails to disclose, teach, or suggest a server operable to "***provide*** at least some of [the information] ***to the particular seller,***" let alone "***provide*** at least some of [the information] ***to the particular seller to allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers.***"

"A claim is anticipated only if ***each and every element*** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added); M.P.E.P. § 2131. In addition, "[t]he identical invention must be shown in ***as complete detail*** as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added); *see also* M.P.E.P. § 2131. Furthermore, "[t]he elements must be arranged as in the claim under review." *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990); M.P.E.P. § 2131. The distinctions discussed above clearly illustrate that *Mathur* fails to disclose, either expressly or inherently, each and every limitation recited in Applicant's Claim 1, as is required under the M.P.E.P. and governing Federal Circuit cases. For this reason alone, the anticipation rejections based on *Mathur* are inappropriate.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 23 and its dependent claims. For at least analogous reasons,

Applicant respectfully requests reconsideration and allowance of independent Claims 1, 12, and 34-35 and their dependent claims.

B. Applicant's Dependent Claims are Allowable over *Mathur*

Dependent Claims 2-11, 13-22, and 24-33 depend from independent Claims 1, 12, and 23, respectively, which Applicant has shown above to be clearly allowable over *Mathur*, and are allowable for at least this reason. Applicant's dependent claims recite further patentable distinctions over *Mathur* beyond those recited in independent Claims 1, 12, and 23. Certain of these additional distinctions are discussed below with reference to independent Claim 35. With respect to Applicant's dependent claims, as discussed above, the Examiner merely summarized certain of *Mathur*'s disclosures and then rejected Applicant's dependent claims as being anticipated by *Mathur*. The Examiner appears to have ignored many limitations recited in Applicant's claims, particularly in Applicant's dependent claims, that are clearly not disclosed, taught, or suggested by *Mathur*. As discussed above, an anticipation rejection requires each and every element set forth in the claim to be found, either expressly or inherently described, in a single prior art reference. For at least these reasons, Applicant respectfully requests reconsideration and allowance of dependent Claims 2-11, 13-22, and 24-33.

C. Independent Claim 35 is Allowable over *Mathur*

Applicant respectfully submits that independent Claim 35 is allowable for at least reasons analogous to those discussed above with respect to independent Claim 23. In addition, *Mathur* fails to disclose, teach, or suggest a server operable to perform the following limitations recited in Claim 35 even prior to the amendments presented in this Response:

- record query information associated with a search query for a buyer of one or more databases containing product data, ***the query information reflecting one or more product attribute values and one or more seller attribute values specified in the search query;***
- record presentation information associated with presentation of a plurality of search results to the buyer, each search result comprising data for a product matching one or more search criteria specified in the search query, the search results comprising one or more search results reflecting product data for a particular seller, ***the presentation information reflecting a position of a search***

- result for the particular seller within an ordered display of the search results;*
and
- record selection information associated with selection by the buyer of a particular search result from among the plurality of search results, the particular search result comprising data for a particular product matching one or more search criteria specified in the search query, *the selection information reflecting:*
 - whether the buyer considered one or more search results for the particular seller;*
 - one or more product attribute values or seller attribute values for one or more search results for the particular seller considered but not selected by the buyer;*
 - a position of a search result for the particular seller within an ordered display of the search results;* and
 - one or more product attribute values or seller attribute values for the search result selected by the buyer;* and
 - a position of the selected search result within the plurality of search results presented to the buyer.*

Mathur merely discloses that several search engines mine information contained in user search queries and track the contents of documents (e.g., web pages) accessed by the user using the search engine (e.g., the web pages accessed by the user, the content of the web pages, and transactions performed by the user using the web pages). (Column 4, Lines 31-44) These disclosures of *Mathur* fail to disclose, teach, or suggest at least the above-indicated limitations recited in Claim 35.

Given that the Examiner did not indicate where in *Mathur* the above-indicated limitations are purportedly disclosed, Applicant must conclude that the Examiner did not give proper patentable weight to these limitations. If Applicant's conclusion is incorrect and the rejections are maintained, as requested in the previous Response, Applicant requests the Examiner to clarify his position in a new Office Action by indicating what disclosures in *Mathur* the Examiner believes disclose these limitations.¹ Again, as discussed above, "[a]

¹ Applicant notes that the Examiner has not substantively responded to these arguments, but merely focused on Applicant's arguments regarding "product data." While Applicant's arguments with respect to *Mathur*'s failure to disclose, teach, or suggest "product data," as recited in Applicant's claims, are sufficient to patentably distinguish Applicant's claims from the disclosure of *Mathur*, *Mathur*'s clear failure to disclose, teach, or suggest the additional limitations recited in Claim 35 makes the patentability of Claim 35 over *Mathur* even more clear.

Because the Examiner did not consider Applicant's arguments presented in the previous Response, Applicant respectfully submits that the Examiner prematurely issued a Final Office Action. According to 37 C.F.R. § 1.112, after a reply by Applicant to a non-final Office Action, the Application will be reconsidered and again examined. By not considering Applicant's arguments presented in the previous, non-final Response, or by not providing Applicant with any explanation as to why the Examiner did not find those arguments persuasive, the Examiner did not properly reconsider and again examine the Application, as required under 37 C.F.R. § 1.112. Furthermore, "[w]here the applicant traverses any

claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, “[t]he identical invention must be shown in as complete detail as contained in the . . . claim.” M.P.E.P. § 2131 citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Furthermore, “[t]he elements must be arranged as in the claim under review.” *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990); M.P.E.P. § 2131. *Mathur* fails to disclose, teach, or suggest at least the above-indicated limitations recited in Claim 35.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 35.

IV. No Waiver

All of Applicant’s arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner’s rejections.

rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and ***answer the substance of it.***” M.P.E.P. § 707.07 (f) (emphasis added). Applicant respectfully submits that the Examiner did not answer the substance of Applicant’s arguments with respect to the allowability of Applicant’s claims under 35 U.S.C. § 102 in that the Examiner did not even refer to several portions of Applicant’s lengthy discussion of the deficiencies of *Mathur* with respect to Applicant’s claims. Thus, for the Examiner to properly make the current Office Action final, Applicant respectfully submits that the Examiner was required to have at least examined the Application in light of Applicant’s previous Response (including consideration of the arguments).

For at least these reasons, Applicant respectfully requests that the Examiner withdraw the finality of the current Office Action and consider Applicant’s arguments and amendments before issuing any subsequent Office Action or, more appropriately, issue a Notice of Allowance.

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

Applicant believes no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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